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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,853	04/14/2004	Chikafumi Yokoyama	54769US009	5500

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,853

Applicant(s)

YOKOYAMA, CHIKAFUMI

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/913,687.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

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1. The first line of the specification needs to be updated to reflect that the parent application, U.S. Pat. App. 09/913,687, has issued as U.S. Pat. No. 6,843,952.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pub. No. 08-273537 (previously made of record in the I.D.S. filed on 10 June 2004; hereinafter "JP '537").

Initially, it is noted that claim 10 recites an "assembly of a mold for making a substrate for a plasma display panel comprising base and ribs" in lines 1 and 2. The claim then recites "said mold having..." in line 2. Based on this language, the claim has been interpreted as though the assembly

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phrase in lines 1 and 2 is the preamble of the claim, and the transitional phrase of the claim is "having" in line 2, which is equivalent to open-ended "comprising" terminology. See MPEP 2111.03. Thus, the claim is defining a mold assembly.

Claim 10 further defines a rib precursor for forming the ribs of the plasma display panel. This precursor is part of the material to be used with the mold assembly in order to obtain the plasma display product. It is well settled, however, that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP 2115. Thus, the rib precursor is not germane to the determination of patentability of the claimed mold assembly apparatus.

Claim 10 still further defines how the mold is made in lines 4-7. Specifically, the mold is defined as being made by using photo-setting components in relation the rib precursor. This limitation is therefore also dependent on the intended use of the claimed apparatus because of the relation to the used rib precursor. Moreover the patentability of a product (in this case- the mold assembly apparatus) does not depend on its method of production. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 535, 173 USPQ

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685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); MPEP § 2113.

JP '537 discloses a mold assembly for making a substrate for a plasma display panel. In the embodiment depicted in Figs. 1a and 1b, the mold assembly (2) comprises concave portions (23). As also shown in Fig. 1b, the mold is flexible, and is transparent to radiation for curing resin when used to form the plasma display panel product.

As noted above, the intended use of a claimed apparatus is not germane to the issue of patentability of the apparatus. In this particular case, JP '537 discloses a mold apparatus with all of the defined structural features recited in claim 10, and moreover is used in making a plasma display panel. The apparatus is thus readily capable of being used with a rib precursor as defined in claim 10, and therefore anticipates this limitation of the claim.

As also noted above, the process by which the product-apparatus is made not germane to the issue of patentability of a claimed apparatus. In this case, JP '537 discloses a mold apparatus with all of the structural features defined in claim 10, and therefore anticipates the claim, regardless of its method of manufacturing.

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4. Claims 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Chiu et al. (U.S. Pat. No. 6,247,986).

Chiu discloses a mold for making, among other things, plasma display panels. The mold assembly (30) comprises concave portions (defined between ribs 24). The mold assembly is flexible, and is transparent to radiation (cl. 10, ll. 48-57 & cl. 11, ll. 44-48).

As noted above, the intended use of a claimed apparatus is not germane to the issue of patentability of the apparatus. In this particular case, Chiu discloses a mold apparatus with all of the defined structural features recited in claim 10, and moreover is used in making a plasma display panel. The apparatus is thus readily capable of being used with a rib precursor as defined in claim 10, and therefore anticipates this limitation of the claim.

As also noted above, the process by which the product-apparatus is made not germane to the issue of patentability of a claimed apparatus. In this case, Chiu discloses a mold apparatus with all of the structural features defined in claim 10, and therefore anticipates the claim, regardless of its method of manufacturing.

5. The following reference cited but not relied upon is deemed pertinent to the instant application:

Sakai et al. (U.S. Pat. No. 5,580,511) discloses a method of forming thick film pattern and material for forming thick film pattern.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

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see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Patent Examiner
A.U. 1722

6-10-5